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OFFICE OF PETITIONS

In re Application of :
Yoshiki Nishitani et al :
Application No. 09/758,632 : DECISION ON PETITIONS UNDER
Filed: January 10, 2001 : 37 CFR 1.8(b) AND 37 CFR
Attorney Docket No. 393032016800 : 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.8(b), filed June 1, 2006, requesting withdrawal of the holding of abandonment in the above-identified application and on the concurrently filed renewed petition under 37 CFR 1.313(c)(2) to withdraw the application from issue.

The petition under 37 CFR 1.8(b) is GRANTED.

The petition under 37 CFR 1.313(c)(2) is GRANTED.

DISCUSSION OF PETITION UNDER 37 CFR 1.8(b)

This application was held abandoned for failure to timely take appropriate action in reply to the Notice of Allowance and Fee(s) Due (Notice), mailed October 19, 2005; i.e., request that the previously paid issue fee be applied towards the new Notice on or before January 19, 2006. A Notice of Abandonment was mailed on April 6, 2006. A petition to withdraw from issue was filed on April 13, 2006 and dismissed in a decision mailed May 4, 2006 in view of the failure of the file record to indicate timely submission of a reply to the Notice of October 19, 2005.

Petitioner states that a timely reply was mailed via certificate of facsimile transmission on October 28, 2005, which included Fee(s) Transmittal Form-Part B. In support, petitioner has submitted a copy of the previously facsimile transmitted correspondence, bearing a certificate of transmission date of October 28, 2005, which would have rendered the reply timely if made of record in the instant file. Additionally, petitioner has submitted a copy of the Auto-Reply Facsimile Transmission, which discloses receipt of 2 pages (including the cover page) in the USPTO on October 28, 2005 at 6:19:59 PM (EDT) of Part B of the Fee(s) Transmittal form, as denoted on the cover page. Further, petitioner has provided a statement by Ms. Beverly Carter (Senior Paralegal of the firm of

Morrison and Foerster) attesting to the previously timely transmission of the Fee(s) Transmittal Form-Part B on October 28, 2005.

The file record does not include the originally submitted papers. Failure to receive correspondence which includes a certificate of mailing or certificate of facsimile transmission is addressed in 37 CFR 1.8(b), reproduced below:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

The petition satisfies the above requirements of 37 CFR 1.8(b). Accordingly, the holding of abandonment for failure to timely file a reply to the Notice of October 19, 2005 is hereby withdrawn and the application restored to pending status.

The copy of the reply received with the petition will be accepted in place of the reply shown to have been transmitted by facsimile on October 28, 2005.

DISCUSSION OF PETITION UNDER 37 CFR 1.313(c)(2)


Petitioner requests that this application be withdrawn from issue for consideration of an Information Disclosure Statement. Additionally, the petition is accompanied by a Request for Continued Examination under 37 CFR 1.114.

The petition complies with the conditions of 37 CFR 1.313(c)(2). Accordingly, this application is withdrawn from issue for consideration of a submission (IDS) under 37 CFR 1.114 (request for continued examination).

Petitioner is advised that the issue fee paid in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.¹

Telephone inquiries should be directed to the undersigned at (571) 272-3218.

This application is being referred to Technology Center AU 2837 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.


Frances Hicks
Petitions Examiner
Office of Petitions

¹ The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B - Fee(s) Transmittal Form (along with any balance due at the time of submission), which includes the following language thereon: "The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee in the application identified above." Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).